DETAILED ACTION

1. Applicant's request for withdrawal of the last Office Action, which referred to a different application, is granted. The following Office Action replaces the last Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent WO 03/097299.

European Patent WO 03/097299 discloses the claimed invention except for the dimensions of the elements. However the dimensions may be obtained through experimentation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to tool of European Patent WO 03/097299 to have the claimed dimensions since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

4. **Claims 1, 2, 5-11 and 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent WO 03/011527.

European Patent WO 03/011527 discloses the claimed invention except for the dimensions of the elements. However the dimensions may be obtained through experimentation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to tool of European Patent WO03/011527 to have the claimed dimensions since it has been held that discovering an optimum

value of a result effective variable involves only routine skill in the art. In re Boesch, 617.F.2d 272,205 USPQ 215 (CCPA 1980).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Omum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) oi" 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
Claim 1 is rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending application 10/578,201. Although the conflicting Claims are not identical, they are not patentably distinct from each other because it is dear that all elements of claim 1 of the instant invention 10/564,667 are found in claim 11 of copending application 10/578,201. The differences between claim 1 of 10/564,667 and claim 11 of copending application 10/578,201 lies in the fact that copending application 10/578,201 claims include many more features and is thus much more specific (for example, claim 1 requires "that has a hub with at least a fastening means")• Thus claim 1 of

10/311,046 is in effect a "species" of the "generic" invention of claim 11 of copending application 10/578,201. It has been held that the generic invention is "anticipated" by the "species"• See In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 1, of 10/564,667, is anticipated by claim 11, of copending application 10/578,201 it is not patentably distinct from claim 11. The diamensi0ns of the elements as discloses in the claims of 101564,667 are not claimed in copending application 10/578,201. However the dimensions may be obtained through experimentation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to tool of application with the claimed dimensions of 10/564,667 since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

4. Applicant's arguments filed 8/17/07 have been fully considered but they are not persuasive.

5. In response to applicant's argument that European patent document '299 does not disclose that the fastening means is located on such a partial circle which is to be dimensioned to provide reliable and easy installation of the insertion tool on the angle grinder using a keyless system, the '299 document discloses the claimed features except for the dimensions of the elements. It should be noted therefore, that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

6. In response to applicant's arguments that European patent document '527 does not disclose that the first fastening means is located on a partial circle with a radius

dimensioned provide reliable and easy installation of the insertion tool on the angle grinder using a keyless system, please see item #5 above.

7. In response to applicant's arguments that application # 10/578,201 discloses a tool receiving device of an angle grinder for receiving an insert while the instant application (10/564,667) discloses a specific construction or dimensioning of a hub of the insertion tool on the fastening means on a partial circle with a special radius, hence the double patenting rejection is improper. The elements claimed in the instant application are, in fact, a species of those claimed in copending application #10/578,201. Therefore, the rejection is proper.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN J. GRANT whose telephone number is (571)272-4484. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ajg

/Joseph J. Hail, III/

Supervisory Patent Examiner, Art Unit 3723